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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,355	07/25/2002	Jean-Claude Basset	SCP061792	1390

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EXAMINER

AUSTIN, SHELTON W

ART UNIT	PAPER NUMBER
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2112

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/22/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/980,355

Applicant(s)

BASSET, JEAN-CLAUDE

Examiner

Shelton Austin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/29/2001.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 7 is objected to because of the following informalities: "the Internet application" lacks antecedent basis. There is no mention of an Internet application in claim 1, which claim 7 is dependent upon. Claim 1 discloses "a supplementary processing module able to run a predetermined software application", failing to specifically recite an Internet application. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "internet-type processing means" is vague and indefinite. "Internet-type processing means" does not have any art recognized definition and the specification fails to provide any explicit definition for the term, therefore, one would not know the metes and bounds of the claimed invention.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 17-18 fail to include a computer

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readable medium as part of the software product. Claim 19 makes it optional to include a data medium as part of the software product, therefore failing to specifically limit the invention to a computer readable medium. There is no explicit and deliberate definition in the specification that the product must include the medium. Therefore, the software product would reasonably be interpreted by one of ordinary skill in the art as descriptive material, per se.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10, 12-14, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ullman et al. (US 6,018,768, '768) in view of Kato (US 7,058,129, '129).

It was known in the art at the time the invention was made that in digital television, the television signals broadcasted via a predetermined communications medium are received and decoded by a digital-television receiver/decoder. In general, such a receiver/decoder comprises an input interface suitable for receiving digital-television signals originating from a predetermined broadcast network and for delivering a digital stream of television signals. A typical receiver/decoder also comprises a demultiplexer suitable for extracting, from the digital stream, digital sequences relating to a chosen television program and a decoder module suitable for converting the digital

sequences thus extracted into television signals compatible with a visual-display module.

In regards to claim 1, '768 teaches a module for recording and playing digital sequences of digital-television programs (col. 10, lines 9-10); and an execution module suitable, at the request of a user, for launching the playing of the digital sequences relating to said television program thus recorded, in synchronism with the initialization and marking information, wherein it further comprises a supplementary processing module able to run a predetermined software application further containing said initialization and marking information, the software application being run in synchronism and in interactive mode with the playing of the digital-television program (col. 9, lines 59-67—col. 10, lines 1-3; col. 10, lines 35-38, lines 45-48; col. 10, line 66—col. 11, line 1).

'768 teaches using time-stamped web sites sent to users during playback of a pre-recorded program, but fail to teach specifically using initialization and marking information relating to the start and to the end of a television program to cause recording of a digital sequence.

In analogous art, '129 teaches a processing module suitable for receiving initialization and marking information relating at least to the start and to the end of a chosen television program (col. 11, lines 36-42), as well as to the reception/extraction of the digital sequences relating to said television program, and for comparing it with the television digital stream originating from the demultiplexer/extractor module, said processing module being suitable, moreover, in response to a positive comparison, for

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causing the recording of the digital sequences relating to said chosen television program as well as the initialization and marking information, in the record/replay module (abstract; col. 9, line 61—col. 10, line 22; col. 13, line 55—col. 14, line 11).

It would have been obvious to one at the time the invention was made to modify the invention of '768 to include, in the recording portion, initialization and marking information to cause the recording in order to perform seamless reproduction of plural audiovisual programs (abstract; col. 3, lines 8-16 & col. 14, lines 37-42).

In regards to claim 2, '768 teaches wherein the supplementary processing module consists of Internet-type processing means (col. 7, line 34-41) suitable for cooperating with memory-storage means able to store an Internet browser serving for Internet browsing, and in that the receiver/decoder device further comprises a communications module able to communicate with a remote server according to an Internet-type (col. 12, lines 53-54) communications protocol or the like (col. 7, lines 41-52; col. 9, lines 43-44).

In regards to claim 3, '768 teaches wherein the communications module in claim 2 is able to download the software application originating from the remote server (col. 9, lines 49-50).

In regards to claim 4, '768 teaches wherein the device in claim 1 comprises a media player able to read a data medium containing the software application (col. 5, lines 27-29).

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In regards to claim 5, '768 teaches wherein the device in claim 1 comprises means suitable for receiving the software application with the digital-television stream (col. 7, lines 49-51).

In regards to claim 6, '768 teaches wherein execution module is suitable for launching the playing of the digital sequences relating to the chosen television program and the running of the software application on the same visual- display module (Fig. 8; col. 9, lines 45-47; col. 10, lines 26-27; col. 11, lines 2-11).

In regards to claim 7, '768 teaches wherein the device of claim 1 further comprises man/machine interface means, the actuation of which allows the user to interact simultaneously and in synchronism in the playing of the recorded television program and in the running of the Internet application (col. 11, lines 12-23).

In regards to claim 8, '768 teaches wherein the Internet processing means of claim 2 are suitable for cooperating with the visual-display module as well as the man/machine interface means of the receiver/decoder device (col. 7, lines 48-51; col. 11, lines 16-18).

In regards to claim 9, '769 teaches the ability to allow running of the Internet application in local mode and/or in cooperation with the remote server, in synchronism with the playing of a video (col. 11, lines 2-11).

'769 fail, however, to teaches demultiplexer/extractor module is able to extract the initialization and marking information of the television program.

In analogous art, '129 teaches a decoding device with a first separation unit and a second separation unit, both used to extract marking info relating to picture data at the beginning and the end of skipping (col. 16, lines 23-31).

It would have been obvious to one skilled in the art at the time the invention was made to modify the invention of '768 to include a decoding device able to extract the initialization and marking information for recording and reproducing, therefore making it possible to read out plural audio visual programs to reproduce the read-out program by seamless skipping reproduction (col. 16, lines 6-8).

In regards to claim 10, '768 teaches wherein the Internet processing means are suitable, in cooperation with the processing means of the receiver/decoder, for driving the record/replay module (col. 10, lines 4-10).

In regards to claim 12, '768 teaches wherein the device of claim 1 further comprises an image-composition module suitable for receiving the video images output by the decoder module as well as the graphics images output by the Internet processing means, so as to combine them according to a chosen image-composition mode (col. 9, lines 50-63; col. 9, line 66—col. 10, line 3).

In regards to claim 13, '768 teaches wherein the image-composition mode of claim 12 is of overprint, multi-windowing, text, image-combining type (Fig. 8; col. 11, lines 2-11).

In regards to claim 14, '768 teaches the device of claim 12 wherein the image-composition module further comprises a first memory suitable for containing the video images output by the decoder module; a second memory suitable for containing the

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graphics information output by the Internet processing means; and a third memory suitable for containing an image-composition program (col. 9, lines 44-45; col. 10, lines 16-18). '768 teaches a memory that stores the client software as well as Web browser software. The memory would be suitable for containing video images, graphics information and an image-composition program. '768 also teaches image-processing means suitable for extracting the chosen information from the first and second memories depending on the composition program, so as to produce the composite images (col. 9, lines 13-16) and a module for synchronization of the visual-display module, so as to synchronize the composition of images output by the two memories (col. 9, lines 18-20).

Again, it was known in the art at the time the invention was made that in digital television, the television signals broadcasted via a predetermined communications medium are received and decoded by a digital-television receiver/decoder. In general, such a receiver/decoder comprises an input interface suitable for receiving digital-television signals originating from a predetermined broadcast network and for delivering a digital stream of television signals. A typical receiver/decoder also comprises a demultiplexer suitable for extracting, from the digital stream, digital sequences relating to a chosen television program and a decoder module suitable for converting the digital sequences thus extracted into television signals compatible with a visual-display module. It was also known in the art at the time the invention was made that there exists a method of processing digital-television signals by receiving the digital-television signals originating from a predetermined broadcast network and delivering a digital

stream of television signals; extracting, from the digital stream, digital sequences relating to a chosen television program; and converting the digital sequences thus extracted into television signals compatible with a visual-display module.

In regards to claim 16, '768 teaches, at the request of a user, launching the playing of the digital sequences relating to said television program thus recorded, wherein it further comprises a prior step of implementing a software application able to contain, in addition, said initialization and marking information, and in that the playing step is run in synchronism and in interactive mode with the running of the software application with the aid of the initialization and marking information (col. 9, lines 59-67—col. 10, lines 1-3; col. 10, lines 35-38, lines 45-48; col. 10, line 66—col. 11, line 1).

'768 teaches using time-stamped web sites sent to users during playback of a pre-recorded program, but fail to teach specifically receiving initialization and marking information relating to the start and to the end of a television program to cause recording of a digital sequence.

In analogous art, '129 teaches receiving initialization and marking information relating at least to the start and to the end of a chosen television program (col. 10, lines 15-22; col. 11, lines 36-42), as well as to the reception/extraction of the digital sequences relating to said chosen television program, and comparing it with the television digital stream originating from the demultiplexer/extractor module; in response to a positive comparison, causing the recording of the digital sequences relating to said chosen television program as well as the initialization and marking information, in the

record/replay module (abstract; col. 9, line 61—col. 10, line 14; col. 13, line 55—col. 14, line 11).

It would have been obvious to one at the time the invention was made to modify the invention of '768 to include, in the recording portion, receiving initialization and marking information to cause the recording in order to perform seamless reproduction of plural audiovisual programs (abstract; col. 3, lines 8-16 & col. 14, lines 37-42).

In regards to claim 17, '768 teaches a software application capable of being run in synchronism and in interactive mode with the playing of a digital-television program. '768 also teaches using time-stamped web sites sent to users during playback of a pre-recorded program, but fail to teach specifically receiving initialization and marking information relating to the start and to the end of a television program to cause recording of a digital sequence.

In analogous art, '129 teaches a software product comprising initialization and marking information relating at least to the start and to the end of a chosen digital-television program (col. 10, lines 15-22; col. 11, lines 36-42), said initialization and marking information being intended to be compared with a television digital stream, and, in the event of a positive comparison, said software product being able to cause the recording of the digital sequences relating to said chosen television program as well as the initialization and marking information, wherein said initialization and marking information is contained in a software application (abstract; col. 9, line 61—col. 10, line 14; col. 13, line 55—col. 14, line 11).

It would have been obvious to one at the time the invention was made to modify the invention of '768 to include, in the software product, initialization and marking information to cause the recording in order to perform seamless reproduction of plural audiovisual programs (abstract; col. 3, lines 8-16 & col. 14, lines 37-42).

In regards to claim 18, '768 teaches wherein the software application of claim 17 is capable of being run on-line with a remote server (Fig. 4—data server [90]; col. 6, lines 5-10).

In regards to claim 19, '768 teaches wherein the software application of claim 17 is capable of being contained on a data medium, and/or distributed by downloading (col. 5, lines 27-29).

6. Claims 1, 2, 10, 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ullman et al. (US 6,018,768, '768) in view of Kato (US 7,058,129, '129), and further in view of Ellis et al. (US 6,665,869, '869).

'768 teaches the limitations of claims 1, 2 and 10 for the reasons above.

In regards to claim 11, '768 teaches an operational control panel that gives the subscriber the flexibility to go back and retrieve web pages that were of interest, but fail to teach controlling of a record/replay module.

In analogous art, '869 teaches a set-top box (processing means) that controls recording and other features of a program using an infrared transmitter and receiver. The commands are given through a remote control, keyboard, mouse, touch-pad and other various devices (Fig. 1—34; Fig. 2—30a, 30b, 30c; col. 4, lines 46-51; col. 4, line 66—col. 5, line 12; col. 5, lines 25-29).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of '768 to include a controlling device used to deliver commands in order to control a set-top box, a videocassette recorder and a television (col. 4, lines 51-53).

In regards to claim 15, '768 teaches a modem, or two-way cable, that connects the Internet to the PC. '768 fail, however, to specifically teach a serial port and or a high-throughput port that can connect peripheral equipment.

In analogous art, '869 teaches a set-top box (receiver/decoder—col. 5, lines 34-36) containing one or more data ports able to connect peripheral equipment, such as a printer. The data port could be of USB standard or IEEE 1394 bus standard (Fig. 2—42; col. 5, lines 25-29).

It would have been obvious to one skilled in the art at the time the invention was made to modify the invention of '768 to include links of serial and/or high-throughput link type in order to provide the ability to interface with local equipment such as a personal computer, printer or the like (col. 5, lines 14-15).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelton Austin whose telephone number is (571) 272-9385. The examiner can normally be reached on Monday through Thursday from 7:30-5:00. The examiner can also be reached on alternate Fridays from 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker whose telephone number is (571) 272-0911, can be reached

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on Monday through Thursday from 7:30-5:00. The supervisor can also be reached on alternate Fridays from 7:30-4:00. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shelton Austin
12/18/2006



JEFFREY STUCKER
SUPERVISORY PATENT EXAMINER